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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/362,547	01/03/1995	ROLF WIEDERMANN	MO-4188/LEA-	2914

7590 10/16/2003

BAYER CORPORATION  
PATENT DEPARTMENT  
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EXAMINER
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COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 10/16/2003

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**GROUP 1700** BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 1003

Application Number: 08/362,547  
Filing Date: January 03, 1995  
Appellant(s): WIEDERMANN ET AL.

\_\_\_\_\_  
N. Denise Brown  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed July 24, 2003.

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims (4,5,7,8 & 9) and (3 & 6) do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5,096,933

VOLKERT

3-1992

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 3-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volkert(5,096,933).

Volkert discloses processes for the production of rigid polyurethane foams containing isocyanurate linkages prepared by mixing and reacting polyisocyanates, various 2+ hydroxyl group containing higher molecular weight polyols, blowing agents inclusive of alkanes alone, flameproofing agents, and chain extenders/crosslinkers (see the entire document). Volkert's examples utilize sucrose based polyols which are branched and recites trimethylolpropane based polyols which are all branched polyols.

Volkert discloses that alkanes are useful in the preparations of his invention (see again the abstract, column 8 lines 58-59, and the examples, as well as, the entire document). Examiner holds that from such disclosure one of ordinary skill in the art would readily envision the use of pentane and hexane in the practice of Volkert's invention. However, even if this claim element is not anticipated by the teachings of Volkert, then examiner holds that it is prima facie obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. *In re Ruff* 118 USPQ 343; *In re Jezel* 158 USPQ 99; the

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express suggestion to substitute one equivalent for another need not be present to render the substitution obvious. *In re Font*, 213 USPQ 532. Volkert recites the employment of alkanes, and, accordingly, it would have been obvious for one having ordinary skill in the art to have employed any of the equivalent alkanes in the processes of Volkert for the purpose of imparting their known blowing agent effect in order to arrive at the processes of appellants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Volkert differs from appellants' claims in that NCO values of 200-600 (i.e. NCO to OH ratio of 2:1 – 6:1) are not particularly recited. However, Volkert does set forth ranges of variation and selectivity in choosing the NCO contents for conducting the reactions of their concern, and, further, sets forth that it is well known to the ordinary practitioner in the art that increasing NCO content values leads to increased isocyanurate contents which have the known result of increased flame retardance (see again column 11 lines 32-38), as well as, increases in heat and sag resistance (an additional art known effect). Accordingly, it would have been obvious for one having ordinary skill in the art to have increased NCO indices within the teachings of Volkert for the purpose of increasing the relative amount of isocyanate based material in the final products in order to arrive at the processes of appellants' claims in the absence of a showing of new or unexpected results.

**(11) Response to Argument**

Appellants' arguments have been considered but are not persuasive. Regarding the selections of blowing agents, Volkert's teaching is clear in its anticipation of the exclusion of water from its invention, and such is not an element of the obviousness rejection. Similarly, Volkert is clear in its anticipation of the permissibility of cyclopentane as the sole blowing agent, and the recognition of the usefulness of other additional blowing agents does not negate such a

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teaching. In reference to the specific alkanes of claims 3 and 6, examiner maintains the rejection to be proper for the reasons set forth in the rejection above, and appellants' notation of Volkert's recognition of other blowing agent combinations does not negate the applicability of the stated position.

Regarding appellants' arguments in connection with their showing of results by affidavit or otherwise, it is held and maintained that the results for consideration do not rebut the position of obviousness in a manner which is commensurate in scope with the claims. Appellants' affidavit evidence has been considered but the results do not show unexpected results commensurate in scope with the scope of the claims. Further, the results demonstrated do not set forth the appropriate comparison necessary to overcome the rejection as set forth above. The necessary comparison for claims 3-9 would need to demonstrate unexpected results attributable to variations in isocyanate index values, and for claims 3 and 6 showings attributable to the selection of alkanes would additionally be acceptable. However, appellants' results do not meet the necessary burden and, therefore, are not suitable in overcoming examiner's instantly held rejection.

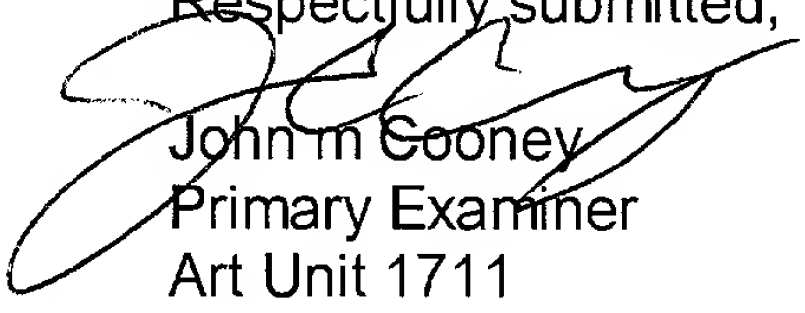
For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



John M. Gooney  
Primary Examiner  
Art Unit 1711

JMC

October 8, 2003

Conferees

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